

**REMARKS****Introduction**

Claims 1-14 were examined in the September 8, 2004 office action. In that action, the examiner indicated that claims 8-12 and 14 are allowable; rejected claims 2 and 7 on the basis that their use of the term "render" renders them indefinite; and rejected claims 1-7 and 13 on prior art grounds.

For the following reasons, it is respectfully submitted that claims 1-7 and 13 are patentable. New claims 15-20 are presented.

**The § 112 Rejections**

The examiner stated that the use of "render" in claim 2's phrase "rendering the content" and claim 7's phrase "content rendering" renders these claims indefinite, and rejected them under 35 U.S.C. § 112. It is respectfully submitted that content rendering is a well-known concept and locution in the digital media realm. The hit list of a search of "content rendering" and analogous forms in the USPTO database yielded a hit list of 195 patents, and the first 50 hits are appended. A cursory review of the titles shows that most are in the digital media field, and a sampling of these shows use of "content rendering" and the like in a manner analogous to applicant's. Accordingly, withdrawal of the § 112 rejection is respectfully requested.

**The § 102 Rejections**

The examiner rejected claims 1, 4, 5, and 13 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,888,798 to Earnest. It is respectfully submitted that these rejections were improper, for the following reasons.

The examiner rejected claim 1 based on Earnest's disclosure at col. 2 line 60 - col. 3 line 22. The examiner cited col. 3 lines 10-15 as disclosing two elements of claim 1: sending a signal from

the user device requesting additional permissions, and receiving at the user device data representing additional permissions. However, all that the cited passage discloses about additional permissions is:

At the time of the initial delivery of the software, the user is given capability keys for only those elements that the user has purchased or for which the user is otherwise authorized. If the user later obtains additional capability keys corresponding to newly authorized elements, the user is then able to access the corresponding newly authorized elements. (Col. 3 lines 7-14; emphasis added)

All that is necessary for the user of an Earnest system to unlock a protected software element is to have possession of the appropriate capability key, which the user enters into the system through a keyboard or equivalent input device. (Col. 3, lines 44-47; col. 2 lines 60-66.) The above-quoted passage cited by the examiner does not say anything about how a user later obtains additional capability keys, and, in particular, does not state or suggest that a signal is sent from the user's computer system to request them and that a signal representing them is received at the user's computer system, as claimed. Consistent with the cited passage a capability key could, for example, be printed on paper and mailed to the user without any request to do so.

Claim 13 was rejected on the same basis as claim 1; the examiner stated that claim 13 is identical to claim 1 except for additional limitations of the electronic media being a content object containing text, and the specified use of the media being performing a function using the content. Claims 1 and 13 are certainly not identical in text aside from the above items. In any event, the examiner appears to have overlooked the last clause of claim 13, which specifies that a transmission function is among those that are not permitted. That limitation is not found either in claim 1 or in the cited portions of Earnest.

Claim 4 specifies, if a check of license data shows that use of media in a requested first manner is not authorized, contacting a remote server and performing a licensing transaction with the

remote server, resulting in issuance of second license data by the remote server. In rejecting claim 4, the examiner stated that these limitations are taught by Earnest at col. 3 lines 10-15. Again, the cited portions of Earnest only disclose the user entering a capability key; they do not disclose how the user obtains the key, and, in particular, they do not disclose contacting or performing a licensing transaction with a remote server.

The examiner rejected dependent claim 5 on the ground that at col. 8 lines 33-44 and col. 12 lines 1-8, Earnest teaches the claimed step of informing a user that use of media in a first manner is not authorized prior to contacting and performing a licensing transaction with a remote server. However, the cited portions do not teach informing the user of anything. Rather, in response to an attempt to access a software element using a key that does not match the required key, the Earnest system takes one of several actions. As disclosed at col. 8 lines 33-44, the system may set all capability keys fields to 0. This does not involve informing the user of anything. The user merely will not obtain access to the requested software. Among the many causes for the lack of access, the user might infer that the reason was lack of authorization, but such an inference is not information conveyed by the system, and such an inference might be wrong. As disclosed at col. 12 lines 1-8, in response to an attempt to access a software element using a key that does not match the required key, the Earnest system might instead appear to accept the invalid capability key, and simulate an error that is likely to cause the user to seek maintenance help, whereupon the unauthorized access attempt will be revealed to the maintenance person. This passage teaches *away from* informing the user that the attempted use is unauthorized prior to contacting a remote server to perform a licensing transaction.

The examiner rejected claim 7 under 35 U.S.C. § 102(b) as "anticipated by CrypKey SDK™, CrypKey.com, 1992." That ground for rejection is improper. To the extent that the examiner

intended to rely on the reference as a printed publication, it was not published in 1992, as was indicated in the rejection. The web page was printed out on September 2, 2004, and bears a 2003 copyright notice, both of which are long after the October 13, 1995 priority date of the application. To the extent that the examiner intended to rely on the reference as evidence of what was in public use or on sale, such reliance is improper. All the reference says regarding the 1992 date is "[s]ince 1992, CrypKey has refined CrypKey SDK and other products to ensure ... software works when it's supposed to and doesn't work when it isn't supposed to." That passage does not say that a CrypKey product was in public use or on sale during the relevant time period, or what the attributes were of any such products. Even if it did, it is improper to reject a claim based on prior public use or sale when the evidence of such prior use or sale is advertising posted on a company's web site making assertions about what the company did more than ten years earlier.

#### **The § 103 Rejections**

The examiner rejected claim 2 under 35 U.S.C. § 103(a) as unpatentable over Earnest as applied to claim 1 and U.S. Patent No. 5,343,527 to Moore. As an initial matter, the examiner stated that "Earnest teaches the limitations of claim 1 on which claim 2 depends, but does not teach" certain features allegedly taught by Moore. This is not understood, since claim 2 is independent. Applicant's undersigned attorney assumes that the examiner intended to rely on the same portions of Earnest that were relied on to reject claim 1.

The examiner cited Figs. 3, 4, and 6 of Moore against claim 2, and particularly pointed out Moore's comparator 617. Moore is concerned with enabling an authorized software user to determine whether received software has been corrupted. As described with respect to Fig. 6, at col. 21 line 15 - col. 13 line 13, a user receives encrypted software, an encrypted hash digest of the encrypted software, and an encrypted key. The user hashes the encrypted software using the same

hash function as the software publisher; decrypts the received encrypted hash digest; and compares the results of these processes. If the comparison shows a difference, the software has been corrupted, and the user is alerted to this fact. However, the Moore system does not prevent use of software when the hash comparison check fails, as claimed; the user of a Moore system is able and authorized to decrypt and use the corrupted software. (Col. 12 lines 62-67.)

The examiner cited "col. 8 lines 34-40" as providing motivation to combine Earnest and Moore, but did not specify which reference was intended. In any event, neither reference suggests combining them. Moore is concerned with an authorized user, who has been provided with the necessary keys and hash function by the software publisher and is thus able to decrypt and use the software, and is directed to alerting the user to corruption of the software by means of the hash data. Moore controls access through cryptographic keys. Earnest is concerned with access control, and also addresses access control by means of cryptographic keys. Earnest is directed to restricting access by unauthorized users, and is not concerned with alerting an authorized user to software corruption. Neither Moore nor Earnest suggests controlling user access based on a check of hash data.

The examiner rejected dependent claim 3 over Earnest and Moore as applied to claim 2, and further in view of Schneier, "Applied Cryptography," 2<sup>nd</sup> ed. It is not clear why this reference is considered prior art. The page of this text having a publication or copyright date was not provided. The only date information in the pages provided to applicant consists of ambiguous handwriting by some unidentified person. The day looks like it could be October 18 or 19, and the year looks like it was originally handwritten as 1996 and then someone wrote a 5 over the 6. Even if one of the possible handwritten dates accurately represents a date when the Schneier text is effective as prior art, the earliest such date appears to be October 18, 1995, which is after the October 13, 1995

priority date of the present application. Applicant respectfully requests that the rejection based on Schneier be withdrawn.

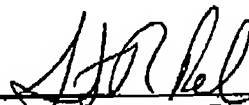
### The New Claims

Earnest describes a system in which several software elements may be installed on a user's computer, and the user may be authorized to use some elements but not others. For each element, the user is either authorized to use it or not; there are no differences in the permitted uses of elements that a user is authorized to use. An additional authorization in Earnest is an authorization to use a different element, not an authorization to make a different type of use of an element whose use is already authorized. New claims 15-16, dependent on claims 1 and 13, respectively, add limitations that the sets of rights and permissions are with respect to the same content, not with respect to different elements that may be included in a package. They are supported in the application, *inter alia*, in Figs. 5, 5A, and 5B. The additional limitations of claims 17, 18, and 19 are supported, *inter alia*, in previously presented claims 9, 10, and 11. The additional limitation of claim 20 is supported, *inter alia*, in Figs. 5B, 7B, and 7H. It is believed that the additional limitations of these claims further patentably distinguish them.

### Conclusion

Reconsideration and further examination is requested, and an early and favorable action is earnestly solicited.

Respectfully submitted,



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